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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,458	11/08/1999	EPHRAIM ZEHA VI	04198.P003	6669
23419	7590	01/21/2004		
COOLEY GODWARD, LLP 3000 EL CAMINO REAL 5 PALO ALTO SQUARE PALO ALTO, CA 94306			EXAMINER JONES, PRENELL P	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 01/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/436,458

Applicant(s)
Zehavi et al.

Examiner
Prenell Jones

Art Unit
2667



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 8, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Response to Arguments

1. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 5, 6, 12, 14, 23, 26, 27, 29, 32 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 16 and 19 of U.S. Patent No. 6,600,726. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims of the present invention are all encompassed by the claimed limitations associated with claims 1, 8, 16 and 19 of US application 09/436,458.

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Claim Rejections - 35 U.S.C. § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant is claiming "a computer having a form factor selected from a group consisting of a desktop, notebook type and palm sized typ" which is not discussed in the specification.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 5, 6, 12, 13, 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Heidari.

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Heidari discloses (Abstract, Fig. 1, col. 1, line 59 thru col. 6, line 60) a dual mode cellular telephone wherein the architecture includes accessing alternately digital mode and analog mode (first/second protocol), DSP, a duplexer that interconnects a transmitter and receiver, micro-controller unit coupled to transceiver and converters, pair of D/A and A/D converters, analog/digital network and associated devices, devices include microphone/speaker, conversion sections share an interconnected transmitter and receiver, it is inherent that the conversion pairs include up/down conversion, in conversion sections IF signals are converted from analog to digital, switches are used to couple and de-couple connection with the interconnected transmitter/receiver, switches used for selecting and switches controlled by micro-controller.

8. Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Shaffer et al.

Regarding claim 29, Shaffer discloses (Abstract, Figs. 1-3, col. 2, line 17-67, col. 3, line 40 thru col. 8, line 20) multiple networks wherein a gateway is used to coordinate communication between networks using/sharing multiple protocols (first/second protocol), and the gateway is used for performing protocol conversions.

Claim Rejections - 35 U.S.C. § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3, 4, 6-9, 15-23, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidari in view of Dean et al.

Regarding claims 3, 4, 6-9, 15-23 and 26, as indicated above, Heidari discloses (Abstract, Fig. 1, col. 1, line 59 thru col. 6, line 60) a dual mode cellular telephone wherein the architecture includes accessing alternately digital mode and analog mode (first/second protocol), DSP, a duplexer that interconnects a transmitter and receiver, micro-controller unit coupled to transceiver and converters, pair of D/A and A/D converters, analog/digital network and

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associated devices, conversion sections share an interconnected transmitter and receiver, it is inherent that the conversion pairs include up/down conversion, in conversion sections IF signals are converted from analog to digital, switches are used to couple and de-couple connection with the interconnected transmitter/receiver, switches used for selecting and switches controlled by micro-controller. Heidari is silent on coupling a signal up conversion section. In analogous art, Dean discloses (Abstract, Figs. 1 and 2, col. 2, line 40 thru col. 8, line 48) a dual mode transceiver whereby the architecture includes multiple up/down conversions wherein the conversions are associated with IF signals, a switch controller is used to control transceiver mode in a coordinated manner, DSP circuitry, up/down conversion sharing an antenna (transmit/receive section), the up/down conversions (states) are coupled and decoupled with respect to the protocols by the switch controller and switch/timing tables for protocol usage. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement coupling/de-coupling up/down conversions (alternating between conversion states) as taught by Dean with the teachings of Heidari for the purpose of further coordinating transmission/reception of the transceiver as associated with protocol use.

11. Claims 10, 11, 24, 25, 27, 28 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidari in view of Dean et al as applied to claims 1 and 23 above, and further in view of Ault et al.

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Regarding claims 10, 11, 24, 25, 27, 28 and 30-33, as indicated above, Heidari discloses (Abstract, Fig. 1, col. 1, line 59 thru col. 6, line 60) a dual mode cellular telephone wherein the architecture includes accessing alternately digital mode and analog mode (first/second protocol), DSP, a duplexer that interconnects a transmitter and receiver, micro-controller unit coupled to transceiver and converters, pair of D/A and A/D converters, analog/digital network and associated devices, conversion sections share an interconnected transmitter and receiver, it is inherent that the conversion pairs include up/down conversion, in conversion sections IF signals are converted from analog to digital, switches are used to couple and de-couple connection with the interconnected transmitter/receiver, switches used for selecting and switches controlled by micro-controller, and Dean discloses (Abstract, Figs. 1 and 2, col. 2, line 40 thru col. 8, line 48) a dual mode transceiver whereby the architecture includes multiple up/down conversions wherein the conversions are associated with IF signals, a switch controller is used to control transceiver mode in a coordinated manner, DSP circuitry, up/down conversion sharing an antenna (transmit/receive section), the up/down conversions (states) are coupled and decoupled with respect to the protocols by the switch controller. Both Heidari and Dean are silent on monitoring transmit/receive workload. In analogous art, Ault discloses (Abstract, col. 1, line 40 thru col. 4, line 67, col. 6, line 12 thru col. 12, line 67) multi-mode system that works in CDMA and analog modes (first/second protocol) sharing the same transceiver, micro-controller monitoring processor/protocol usage (workload). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement monitoring protocol

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usage as taught by Ault with the combined teachings of Heidari and Dean for the purpose of further coordinating protocol usage between networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prenell Jones whose telephone number is (703) 305-0630. The examiner can normally be reached on Monday thru Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Prenell Jones

January 14, 2004


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600
1/15/04